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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,544	10/25/2000	Michael L. Beacham	426882000200	2119

35452 7590 03/12/2004

ACCENTURE C/O MORRISON & FOERSTER
755 PAGE MILL ROAD
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EXAMINER

SNAPP, SANDRA S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/696,544

Applicant(s)

BEACHAM ET AL.

Examiner

Sandra Snapp

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MS

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/10-01-03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statements (IDSs) submitted on 12-19-00 and 10-01-03 were filed in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements have been considered by the examiner.

Specification

The disclosure is objected to because it lacks figure descriptions for Figs. 7A-1, 7A-2, 7B-1, 7B-2, 7C-1 and 7C-2.

The abstract of the disclosure is objected to because it exceeds the 150 word limit, it is too long. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-6, 8-11 and 15-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 1, 3-6, 8-11, 15, 17-20 and 22-25 are indefinite because it is unclear what is meant by a "securities processing system." Is such a system a method or more of a physical system, such as a computer or other similar apparatus. Clarification is required.

Claims 5 and 19 are also indefinite because in both claims, the phrase "the organization" lacks proper antecedent basis since this was the first occurrence thereof. The phrase "the identified critical issues" also lacks proper antecedent basis. Are such issues actually referring to the "assessment issues" of claim 1 or something different?

Claims 15-28 are indefinite because they claim a "system" however system is not clearly defined. It is unclear whether the Applicant is claiming a method or an apparatus. For example, claim 15 has language that claims a form, documentation, documents, etc., then it also has the steps of analyzing, formulating, prioritizing, developing, etc. If it is an electronic system, where is the hardware?

Claims 15-28 are also indefinite because it is unclear what is meant by "button." Is such meant to represent a physical structure, or merely a computer icon?

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-28 are directed to non-statutory subject matter because they lack any reference to technology. The Patent Office has taken the position that claims lacking any reference to

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technology are “nothing more than [an] abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution.” *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001)(Unpublished). Although the Bowman case is not precedential, it is cited herein merely for its content and reasoning. The Examiner suggests amending the claims to include some form of technology, such as a computer, etc. in the body of the claim. It is not sufficient to merely put such technology in the preamble.

Claims 15-28 are directed to non-statutory subject matter because they contain functionally descriptive material that is not embedded in any form of tangible medium. The system claimed has language such as “online” and “processing data tool program,” etc. however there is no express computer executable code or computer executable instructions, such are merely implied. Without such express instructions, there is no nexus between the “system” and the steps it is charged with performing.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Harris et al., Hawkins et al., Nevo et al., Keiser et al., Black et al., Minton, Rickard et al., Segal et al., Belzberg, Kalmus et al., Musmanno et al., Hawkins et al. Kenton, Beacham and Crosby patents and applications disclose various types of electronic trading and securities systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SS


SANDRA S. SNAPP
PATENT EXAMINER
GROUP 3600